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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/473,659

12/29/1999

MAKOTO KIKUGAWA

35.G2530

1271

5514

7590

09/23/2004

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EXAMINER

PHAM, THIERRY L

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 09/23/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,659

Applicant(s)

KIKUGAWA, MAKOTO

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/23/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communication: RCE filed on 7/23/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda (U.S. 6181440), and in view of Guthrie et al (U.S. 6161185).

Regarding claim 1, Masuda discloses an apparatus for conducting a retrieval of document data, comprising:

- (1) storing means (Memory, Fig. 1) for storing the document data;
- (2) a receiver (facsimile device, Fig. 1, col. 2, lines 63-67 and col. 3, lines 1-33) , for receiving from a user a request for retrieval of the document data, with the request including a password (col. 3, lines 8-33);
- (3) a transmitter (network control unit, Fig. 1, col. 3, lines 8-48), for transmitting the password, received by said receiver, to a managing unit (FAX system control unit, Fig. 1) on a network;
- (4) deciding means (FAX System control unit, Fig. 1, col. 6, lines 1-9) for, when said managing unit confirms the password transmitted by said transmitter, receiving a confirmation result from said managing unit to decide, on the basis of said confirmation result, whether or not the user is an authorized user;
- (5) retrieving means (FAX system control unit, Fig. 1, col. -6, lines 1-22) for retrieving the document data stored in said storing means according to a decision result obtained by said deciding means;
- (6) outputting means (printer unit, Fig. 1, col. 6, lines 1-9) for outputting document data retrieved by said retrieving means;

However, Masuda does not disclose expressly, wherein an apparatus for conducting a retrieval of document data, comprising:

- (1) issuing means for automatically issuing a new password in response to receiving from a user a request for retrieval of the document data by said receiver, wherein the user is notified of the new password if the users is authorized; and
- (2) registering means for transmitting the new password, issued by said issuing means, to said managing unit to register the new password as a valid password.

Guthrie, in the same field of endeavor for passwords protected access to documents, discloses:

- (1) issuing means for automatically (server automatically generates a new password, col. 6, lines 42-64) issuing a new password in response to receiving from a user a request for retrieval of the document data by said receiver, wherein the user is notified of the new password if the users is authorized (col. 7, lines 45-62); and
- (2) registering means (server, col. 6, lines 42-64) for transmitting (transmitting via a network, fig. 1) the new password, issued by said issuing means, to said managing unit to register the new password as a valid password.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Masuda as per teachings of Guthrie because of a following reason: to prevent print out of confidential reception images/documents (Masuda, col. 5, lines 55-65)

Therefore, it would have been obvious to combine Masuda with Guthrie to obtain the invention as specified in claim 1.

Regarding claim 2, Masuda further discloses an apparatus according to claim 1, wherein said receiver includes a local receiver (control panel, Fig. 1) for receiving a request from the user, if a local user, and a remote receiver (network control unit, Fig. 1) for receiving a request sent from the user, if a remote user, through a network.

Regarding claim 3, Masuda further discloses an apparatus according to claim 2, further comprising a control panel (control panel, fig. 1, col. 3, lines 8-33) for performing a

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predetermined display in response to a key operation by the user, wherein said local receiver receives a retrieval request and a password inputted from said control panel.

Regarding claim 4, Masuda further discloses an apparatus according to claim 2, further comprising a reader (scanner, Fig. 1), for reading an original to produce image information, wherein said local receiver receives a retrieval request and a password extracted from the image information taken by said reader.

Regarding claim 5, Masuda further discloses an apparatus according to claim 2, wherein said remote receiver receives a retrieval request and a password sent from a terminal through a network (Fig. 1, col. 3, lines 44-48).

Regarding claim 6, Masuda further discloses an apparatus according to claim 2, wherein said remote receiver receives a retrieval request and a password extracted from image information sent from a terminal through a network (Fig. 1, col. 3, lines 44-48).

Regarding claim 7, Masuda further discloses an apparatus according to claim 2, further comprising a facsimile receiver (facsimile device, Fig. 10) for receiving a facsimile image, wherein said remote receiver receives a document, a retrieval request and a password extracted from an image which said facsimile receiver receives.

Regarding claim 8, Masuda further discloses an apparatus according to claim 2, wherein said outputting means outputs document data in a different manner (printer provided by facsimile device, Fig. 1 & 6, or transmits the documents to the information processing device, Fig. 1 & 6, col. 5, lines 9-54) in accordance with whether said receiver behaves as said local receiver or said remote receiver.

Regarding claim 9, Masuda further discloses an apparatus according to claim 8, further comprising a facsimile transmitter (facsimile device 1, Fig. 1) for conducting a facsimile transmission to a predetermined address, wherein said outputting means, when a retrieval request

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is receive through a facsimile reception, transmits document data retrieved by said retrieving means in the form of a facsimile image to a retrieval requesting facsimile unit through the use of said facsimile transmitter.

Regarding claims 10-17 recite limitations that are similar and in the same scope of invention as to those in claims 1-9 above; therefore, claims 10-17 are rejected for the same rejection rationale/basis as described in claims 1-9.

Regarding claims 18-26: Claims 18-26 are the method claims corresponding to the apparatus claims 1-9. The methods are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-9 above.

Regarding claims 27-34: Claims 27-34 are the method claims corresponding to the apparatus claims 1-9. The methods are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-9 above.

Claims 35-51 corresponds to claims 1-9 except computer readable memory medium for storing program is claimed rather that printing system or data output apparatus. All computers/printers have some type of computer readable memory medium (Memory, fig. 1, Masuda) for storing computer programs, hence claims 35-51 would be rejected using the same rationale as in claims 1-9.

Response to Arguments

4. Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

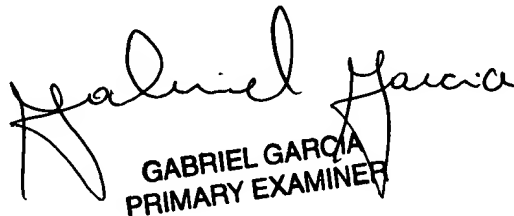
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER